

Serial No.: 10/618,594
Atty. Docket No.: P66091US1

BEST AVAILABLE COPY

REMARKS

Favorable reconsideration is respectfully requested in view of the preceding amendments and the following comments. By this Amendment, claims 1, 7, 21 and 23 have been amended, claim 10 has been canceled without prejudice or disclaimer, claims 11 to 20 have been withdrawn from consideration by the Examiner, and new claims 24 and 25 have been added. Claims 1 to 9 and 11 to 25 are pending in the application.

The amendments to claim 1 find clear and complete antecedent support in the original claims and in the drawings. The amendment to claim 7 is clearly supported by Figures 2E and 2F. The amendment to claim 21 finds clear support in the same manner as claim 23. Claim 24 finds antecedent support in the same manner as claims 1 and 12. Newly presented claim 25 has the same support as claims 1 and 23.

Since the number of claims has been increased by two (dependent) claims, Form PTO-2038 in the amount of \$36.00 is submitted herewith. In the event that any remittance is incorrect, kindly credit or debit Deposit Account 06-1358, and advise the undersigned accordingly.

In response to the restriction requirement, Applicants elect (with traverse) Group I; claims 1 to 5, 7 to 10 and 21 to 25 read on this election.

Please note that the patentability of a product-by-process claim is based upon the product formed and not upon the method by which it was produced. *Ex parte Jungfer*, 18 U.S.P.Q.2d 1796, 1799 (BPAI 1990). A product defined in whole or in part by the method by which it is made is still a product. The patentability of a product does not depend on its method of production -- if the

BEST AVAILABLE COPY

BEST AVAILABLE COPY

Serial No.: 10/618,594
Atty. Docket No.: P66091US1

product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *Ex parte Gavin*, 62 U.S.P.Q.2d 1685 (BPAI 2001).

Accordingly, Applicants respectfully submit that restriction between Applicants' product claims and claim 24 is inappropriate, since they all read on the same product. Also, restriction between claim 24 and Applicants' process claims is also inappropriate since the product of claim 24 is the inherent product of the claims process.

In the prosecution of Applicants' parent application (Serial No. 09/739,768) Applicants submitted amended claims 1 and 2 in an Amendment Under Rule 116 (filed April 7, 2003). In an Advisory Action (Paper No. 12) issued on April 24, 2003, the proposed amendments were refused entry because "they raised new issues that would require further consideration and/or search," presumably based on the terminology: "longitudinally continuous unitary corrugated surface." The proposed claims were thus refused entry. However, the Advisory Action further stated: "if the Amendments were to be entered, the amended claims would overcome the prior art of record."

The claims presented in Applicants' Preliminary Amendment of July 24, 2003, have the very limitations which were previously determined to define patentably over the prior art of record, which is the sole prior art instantly relied upon in the Office Action (Paper No. 9) of June 17, 2004.

The fact that the same prior art is relied upon makes it clear that no further search was required and that entry of the amendment proposed in Applicants' parent application should have

BEST AVAILABLE COPY

BEST AVAILABLE COPY

Serial No.: 10/618,594
Atty. Docket No.: P66091US1

been entered and acted upon in that case rather than forcing refiling of the application in order to have the additional limitations entered.

The objection to claim 1 has been overcome by the instant amendment. The spelling of "corrugated" has been corrected.

The rejection of claims 1 to 3, 7, 10 and 21 to 23 "under 35 U.S.C. §102(b) as being anticipated by Kanao (U.S. Patent No. 4,862,924)" is respectfully traversed. A partial issue involves the meaning of the word "corrugated". Applicants have continuously argued their intended meaning of that word which is in complete conformance with the meaning of "corrugating" in the "McGraw-Hill Dictionary of Scientific and Technical Terms," Second Edition, page 368 (copy herewith), right column, first word, 1978:

Forming straight, parallel, alternate ridges and grooves in sheet metal, cardboard, or other material.

"When the Applicant states the meaning that the claimed terms are intended to have, the claims are examined with that meaning, in order to achieve a complete exploration of the Applicants' invention and its relation to the prior art." *In re Zletz*, 13 U.S.P.Q.2d 1320, 1322 (Fed. Cir. 1989).

No further argument should be required to establish the allowability of Applicants' claims since the definition thereof over applied art has already been determined on the record by the Examiner, as instantly pointed out.

Claim 23 calls for "a laminated layer having a metal film held between two resin films and surrounding the inner resin layer."

BEST AVAILABLE COPY

Serial No.: 10/618,594
Atty. Docket No.: P66091US1

BEST AVAILABLE COPY

It appears that there may be some issue with regard to the term "film" which is defined in part by "Websters New World Dictionary", Third College Edition, page 505 (copy herewith), 1989, as:

A fine, thin skin, surface, layer, or coating.

Nothing whatsoever is found in Kanao which even remotely discloses or suggests "a layer having a metal film held between two resin films" as expressly called for by claim 23.

Nothing is found in Kanao which even remotely suggests "film" within the recognized meaning of that term.

With regard to claim 7, the corrugated surface is along at least a major part of the hose wall. Claim 7 limits the corrugated surface to one-piece, which also distinguishes over Kanao. Furthermore, it limits the outer resin layer the one that has a thickness not exceeding 5mm; no such suggestion is derivable from any part of Kanao's disclosure. Paper No. 9 refers to column 3, lines 39 and 40, which is directed to metal band member 11, which is neither part of the inner resin layer nor part of the outer resin layer.

The belt-like member 1 of Kanao's hose is helically wound over the inner pipe wall B. Thus, the belt-like member 1 has helical joints or gaps on the surface thereof, which will cause insufficient impermeability. The coating pipe wall C, even if used to cover the belt-like member 1, is made of resin and will not serve to provide sufficient impermeability. In contrast, in the hose of the present invention, the smooth tube, including a laminated layer having a metal film, has a unitary (one-piece) corrugated surface without such joints or gaps, thus providing excellent impermeability.

BEST AVAILABLE COPY

BEST AVAILABLE COPY

Serial No.: 10/618,594
Atty. Docket No.: P66091US1

The rejection of claim 4 "under 35 U.S.C. 103(a) as being unpatentable over Kanao . . ." is also respectfully traversed in the same manner and for the same reasons as set forth in the preceding remarks. The thickness requirement of claim 4 is significantly less than anything even remotely suggested by Kanao. Changes in the weather have no relationship to needs addressed and solved by Applicants' claimed invention. In fact, with regard to the needs addressed by the Applicants, nothing would direct their attention to Kanao's entire disclosure. Even though pipes are involved, the involved issues are truly unrelated. With all due respect to the Examiner's conjecture and assertions, nothing is found in Kanao's entire disclosure that would lead to the involved express limitation.

The rejection of claims 5, 8 and 9 "under 35 U.S.C. 103(a) as being unpatentable over Kanao . . . in view of Schave et al. . . ." is also respectfully traversed for the same reasons and in the same manner as previously discussed with regard to Kanao. Schave does not in any way overcome the previously noted efficiencies of the primary reference.

The laminated layer of claim 5 is a spirally wound or longitudinally lapped layer of a laminated tape having the metal film bonded to the resin films. Kanao's metal band member 11 is not actually a layer of the pipe; it is part of the resin-coated metal belt-like member 1. Schave's elongated thin strip of metal (e.g. aluminum) is helically coiled. There is a single helical wire within the casing side wall; the structure called for by claim 5 is neither disclosed nor suggested by Schave, taken alone or in any combination with Kanao.

Schave does not have a spirally wound metal layer; Schave has a layer reinforced with spirally wound wire. Nothing is found in either reference that even remotely suggests the limitations

BEST AVAILABLE COPY

BEST AVAILABLE COPY

Serial No.: 10/618,594
Atty. Docket No.: P66091US1

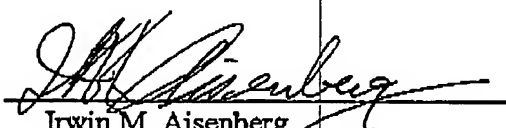
expressly called for by Applicants' claims. The reference to "routine optimization" is expressly challenged when the purpose for such optimization is not even remotely suggested by anything found in the applied art.

Having overcome all outstanding grounds of rejection, Applicants' claims are clearly in condition for allowance, and early action toward that end is respectfully solicited.

Respectfully submitted, .

JACOBSON HOLMAN PLLC

By:


Irwin M. Aisenberg
Reg. No. 19,007

400 Seventh Street, N. W.
Washington, D.C. 20004
Telephone: (202) 638-6666
Date: September 15, 2004
IMA:cwp
R:\AISEN\09-04\P66091US1 A\MD